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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,474	05/15/2001	Yoshimichi Yamanaka	010611	8058

23850 7590 12/19/2002

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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1712

11

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/854,474

Applicant(s)

YAMANAKA, YOSHIMICHI

Examiner

Christopher M. Keehan

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Objections***

The objection to claim 13 has been withdrawn due to Applicant's amendments.

#### ***Claim Rejections - 35 USC § 112***

The rejection of Claims 13-22 under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling has been withdrawn due to Applicant's amendments.

The rejection of Claims 13-22 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn due to Applicant's amendments.

#### ***Claim Rejections - 35 USC § 103***

The rejection of Claims 13-22 under 35 U.S.C. 103(a) as being unpatentable over Kawakubo et al. (4,788,254) in view of Azechi (5,942,583) has been withdrawn due to Applicant's arguments and in light of a new rejection.

### ***Specification***

The disclosure is objected to for the following reasons: Applicant repeatedly refers to "a saturated hydrocarbon polymer containing at least one alkenyl group within its molecule" but this is not clear. It is not clear how a saturated hydrocarbon polymer can have at least one alkenyl group within its molecule; this would appear to render the polymer unsaturated. Reference is made to this in numerous places in the disclosure, too many to cite, and because of this it is difficult to understand the invention of Applicant. Appropriate correction is required.

### ***Claim Objections***

Claims 13, 14, and 18-21 are objected to because of the following informalities: reference is made to components (B), (C), (D), (E), (F), and (G), in the respective claims. As the claims are written, it appears that deleting references to these components by the above-stated letters would be preferable for clarity. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al. (6,451,439 B2). Regarding claims 13 and 15, Okamoto et al. disclose a bonding method for bonding a cured product to a substrate comprising coating a primer composition comprising a silane coupling agent (col.7, line 52-col.8, line 55) on a substrate (Abstract), applying a curable composition comprising a hydrocarbon polymer

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having at least one alkenyl group per molecule onto the primed substrate, specifically polyisobutylene (col.15, line 44-col.16, line 12) and curing the curable composition to obtain the cured product bonded to the substrate (col.16, lines 1-12). Although Okamoto et al. do not specifically disclose curing the alkenyl containing polymer with the primer composition, and a resulting laminate thereof, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have cured the primer and the alkenyl containing polymer together to increase adhesion to the substrate and because it is more cost efficient in one curing step than in two.

Regarding claim 14, Okamoto et al. disclose a silane coupling agent that has a functional group selected from the group as instantly claimed (col.7, line 52-col.8, line 55).

Regarding claims 16 and 17, Okamoto et al. disclose wherein the curable composition has a curing agent containing two or more silicon-bound hydrogen atoms per molecule, and wherein the curing agent is a polyorganohydrogen polysiloxane containing two or more hydrosilyl groups per molecule (col.15, lines 44-53 and col.2, lines 48-59).

Regarding claim 18, Okamoto et al. disclose wherein the composition comprises a polyvalent alkoxysilane and/or a condensation product thereof (col.3, line 18-col.4, line 2).

Regarding claim 19, Okamoto et al. disclose an organoaluminum compound and/or an organotitanium compound (col.8 line 66-col.10, line 15).

Regarding claim 20, Okamoto et al. disclose a hydrosilylation catalyst (col.11, line 41-col.12, line 4).

Regarding claim 21, Okamoto et al. disclose an organic solvent (col.12, lines 16-31).

Regarding claim 22, Okamoto et al. disclose the primer composition providing firm adhesion between various substrates and cured materials. This result of this can be a laminate.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLouise et al. (6,273,985 B1). DeLouise et al. disclose a bonding method for bonding a cured product to a substrate comprising coating a primer composition comprising a silane coupling agent (Abstract), applying a curable composition comprising a hydrocarbon polymer having at least one alkenyl group per molecule onto the primed substrate (Abstract and col.31, lines 55-56), and curing the curable composition to obtain the cured product bonded to the substrate (Abstract).

Regarding claim 14, DeLouise et al. disclose wherein the silane coupling agent has at least one functional group selected from the group as instantly claimed (col.38, line 20-col.39, line 4).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is

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(703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan *CKK*  
December 13, 2002



Robert Dawson  
Supervisory Patent Examiner  
Technology Center 1700